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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/564,875

01/17/2006

Shigeo Yukawa

10873.1823USWO

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52835

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06/08/2009

HAMRE, SCHUMANN, MUELLER & LARSON, P.C.

P.O. BOX 2902

MINNEAPOLIS, MN 55402-0902

EXAMINER

JOY, DAVID J

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

06/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/564,875 | Applicant(s) YUKAWA, SHIGEO | |
| | Examiner David J. Joy | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 3, 11-19 and 21-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-10 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/17/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species (a), Claims 1, 2, 4-10 and 20, in the reply filed on March 23, 2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without** traverse (MPEP § 818.03(a)).
2. Claims 3, 11-19 and 21-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 23, 2009.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 2, 4-10 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 1, 4, 8 and 20 are indefinite due to the fact that they all recite the limitation that "the self-destructive film layer comprises at least a dye migration preventative resin layer ... and a self-destructive layer". However, the initial limitation in the multilayer laminate is that "a self-destructive film layer" is present in the laminate (N.B., *layer* is used in its singular form). Examiner asserts that a singular layer cannot,

in actuality, be made up of several constituent layers that are grouped together and given the same name (i.e., a *self-destructive film layer* cannot comprise at least two layers). Appropriate correction is required.

8. Claims 2, 5-7, 9 and 10 are rejected accordingly, as they all depend upon Claim 1.

9. Claims 1, 2, 4-6, 8-10 and 20 are indefinite due to the inclusion of the seemingly extraneous reference characters in the claims. Given the fact that all of the reference characters that appear in the drawings, that were filed on January 17, 2006, consist of numeric references (see Figures 1-18), it is unclear to what the claimed references characters are referring (i.e., "a surface resin layer **(A)**" --- emphasis added).

Appropriate correction is required.

10. Claim 7 is rejected accordingly, as it is dependent upon Claim 6, which depends upon Claim 1.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

| | | |
|-----------------|---------|---------------|
| US 2003/0165668 | 09/2003 | Yukawa et al. |
| US 2002/0155952 | 10/2002 | Furukawa |
| US 6,299,213 | 10/2001 | Souparis |
| US 6,066,594 | 05/2000 | Gunn et al. |
| US 5,869,160 | 02/1999 | Mason et al. |
| JP 2002-366036 | 12/2002 | Kurz |

(machine translations included of JP reference attached hereto)

The prior art, as a whole, fails to teach or suggest a security sticker comprising a multilayer laminate having all of the requisite layers that are presently claimed, including a dye-migration preventative layer that is situated below the print layer, in an opposite relationship to a resin layer having a weak affinity with a sublimable dye.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Joy whose telephone number is (571) 272-9056.

The examiner can normally be reached on Monday - Friday, 7:00 AM - 3:30 PM EST.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin M. Bernatz, acting SPE for Carol D. Chaney, can be reached on (571)

272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJJ/
Examiner, Art Unit 1794
06/05/2009

/Bruce H Hess/
Primary Examiner, Art Unit 1794